

Appln. No. 10/030,428  
Reply to Office Action of 09/29/03

REMARKS

Favorable reconsideration of this application is respectfully requested.

Claims 1-8 are presently active in this application.

The outstanding Official Action presents a rejection of Claims 1-8 under the first paragraph of 35 U.S.C. §112.

Initially it is noted that the statement of the rejection appears to suggest that the rejection of Claims 1-8 under the first paragraph of 35 U.S.C. §112 is based on the written description requirement thereof and not the separate enablement requirement.

MPEP§2163 notes that written description requirement issues usually arise relative to insuring that the specification as originally filed supports later added claim amendments. As noted in part "A. Original Claims," there is a strong presumption that an adequate written description of the claimed invention is present when an application is filed. While lack of a description of "an essential or critical feature" that "is not conventional in the art or known to one of ordinary skill in the art" in the specification can give rise to a written description requirement rejection, the indication here is that such features that are "conventional in the art or known to one of ordinary skill in the art" need not be set forth.

Turning to the rationale offered in support of the rejection at page 2 of the outstanding Action, it is noted that the outstanding Action first errs by suggesting the amount of pressure to use as the claim 1 reduced pressure is not disclosed. However, page 30, lines 22-26 clearly define a "reduced pressure of  $1 \times 10^3$  Pa to  $5 \times 10^3$  Pa."

This portion of the specification (page 30, lines 20-28) further explains that a KNOWN press machine is used and how the conductive paste is applied to the substrate. As

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to the protection of the circuit foil 1, this foil is on the opposite side of the substrate from the paste loading side as clearly shown in FIG. 1 (D) and discussed here. The use of a KNOWN squeeze to fill the holes with the paste is also discussed here as are other methods. The composition of two examples of suitable conductive pastes are presented at page 10, lines 9-21 of the specification, for example.

Thus, all the questioned features are either actually set forth in the specification or clearly indicated there to be matters that are "conventional in the art or known to one of ordinary skill in the art."

Accordingly, the rejection of Claims 1-8 based upon the written description requirement of the first paragraph of 35 U.S.C. §112 is not appropriate and should be withdrawn.

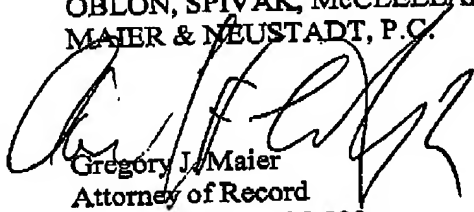
To the extent that the rejection can also be considered to be invoking the separate enablement requirement of the first paragraph of 35 U.S.C. §112, MPEP §2164.01 requires that there be a finding made of a requirement for "undue or unreasonable" experimentation. Thus, while the presence or absence of a specific working example is a factor, it is not determinative of the question of "undue experimentation" as explained in MPEP §2164.01(a) and MPEP §2164.02. Also note MPEP §2164.04 setting forth the "Burden on the Examiner Under the Enablement Requirement" which has not been met here in terms of setting forth a statement as to why the Examiner doubts the truth or accuracy as to what the specification indicates to be KNOWN to those of ordinary skill in the art.

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As no further issues are believed to remain outstanding in this application, it is respectfully urged that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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